

Non-Final Amendment

Serial Number: 10/770,613

Filing Date: February 2, 2004

Title: SPECIAL MULTIPLIER BONUS IN PAI GOW POKER VARIANT

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### **GROUND OF REJECTION**

Claims 1-30 are newly rejected under 35 USC 101 because the claims are directed towards non-statutory subject matter. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385; (Fed. Cir. 2008).

Claims 1, 5-15 and 14-20 have been **NON-finally** rejected under 35 USC 102(b) as anticipated by US Patent No. 5,863,041 (Boylan).

Claims 1-30 have been **NON-finally** rejected under 35 USC 103(a) as unpatentable over US Patent No. 5,863,041 (Boylan) in view of US Patent No. 4,948,134 (Suttle).

**Claim 1-30, all of the claims in this Application, are rejected.**

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### RESPONSE TO THE REJECTIONS

- 1) Claims 1-30 are newly rejected under 35 USC 101 because the claims are directed towards non-statutory subject matter. See *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385; (Fed. Cir. 2008).

**The claims have been appropriately amended to remove this basis of rejection.**

- 2) Claims 1, 5-15 and 14-20 have been NON-finally rejected under 35 USC 102(b) as anticipated by US Patent No. 5,863,041 (Boylan).

**As with any rejection under 35 USC 102 (any section) it is necessary to make a literal comparison of the language of the claims with the full scope of the disclosure of the cited reference. This analytical process is begun in the following table:**

| CLAIM 1   | BOYLAN  | COMMENTS  |
|---|---|---|
| A method of playing a Pai Gow poker wagering card game comprising:<br>a. Players wagering on a Pai Gow game;  | A method of playing a pai gow poker wagering game in which an ante bet is initially wagered and a bonus bet is also wagered by at least one player. Seven cards are then dealt to each player and the dealer, and arranged into a two-card hand and a five-card hand. | Players receive 7 cards each to play pai gow poker.   |
| b. Players placing either an optional or mandatory wager against a pay table on a separate poker-type game that uses a best five-card hand from each player's hand; | and a bonus bet is also wagered by at least one player. Seven cards are then dealt to each player and the dealer, and arranged into a two-card hand and a five-card hand.   | Thereafter, a best poker hand is arranged by the dealer for each player from the seven cards initially dealt to the player, and the bonus bet is paid off if the best poker hand has a poker rank equal to or better than a first predetermined rank (straight) but less than a second predetermined rank (royal flush). <b>Abstract.</b> |
| c. dealing seven-card hands from a set of <u>physical playing cards</u> to multiple player positions and one  | and a bonus bet is also wagered by at least one player. Seven cards are then dealt to each player and the   | <b>Physical cards may be used.</b>  |

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| dealer position;   | dealer, and arranged into a two-card hand and a five-card hand.   |   |
| d. resolving the game of Pai Gow poker;  | Once the dealer's hands are arranged, the dealer immediately pays off in turn each ante bet of the players as follows: (a... (b) ... (c)... As with prior art pai gow games, a hand of a player which ties a hand of the dealer is considered as a win for the dealer.  | <b>This is a description of the normal resolution of Pai Gow poker.</b>   |
| e. forming best five-card poker hands <u>from the physical playing cards</u> for at least each player having placed the wager against the pay table;   | Thereafter, a best poker hand is arranged by the dealer for each player from the seven cards initially dealt to the player, and the bonus bet is paid off if the best poker hand has a poker rank equal to or better than a first predetermined rank (straight) but less than a second predetermined rank (royal flush). <b>Abstract.</b> |   |
| f. resolving wagers with players who have placed the optional <u>or mandatory</u> wager when that player's best five-card poker hand equals or exceeds a predetermined rank; and   | Thereafter, a best poker hand is arranged by the dealer for each player from the seven cards initially dealt to the player, and the bonus bet is paid off if the best poker hand has a poker rank equal to or better than a first predetermined rank (straight) but less than a second predetermined rank (royal flush). <b>Abstract.</b> |   |
| g. providing an additional award <u>immediately from a payable</u> to players who have placed the optional <u>or manda</u> wager i) when that player's best five-card poker hand <u>from the physical playing cards at the</u> | Next, the dealer determines whether the best poker hand of each player has a poker rank better than or equal to the second predetermined rank so that an auxiliary game of chance, such as rolling three dice, is then played.. <b>(Abstract)</b>   | <b>These steps are NOT taught by Boylan. First, Boylan does not make any immediate payment with the higher rank hand, but allows the player to enter a subsequent bonus event where he/she may win or lose. There is no</b> |

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| <p>player's position equals or exceeds a predetermined rank and ii) when a best five-card hand for the dealer <u>from the physical playing cards at the one dealer position</u> is equal to or less than a predetermined rank.</p> |  | <p><b>immediate payment. Second, the alternative step ii) is absent from the teachings of Boylan. These claims are not anticipated.</b></p> |
|--|--|---|

As shown in the word-based comparison above, there is no anticipation of the Applicant's claimed technology by Boylan, at least with regard to the following features:

- a) In addition to a first payable for best-five-of-seven hands, Applicant has an immediate high payout when **TWO EVENTS occur simultaneously – i) a high ranked player hand and ii) a low ranked dealer hand. BOTH EVENTS MUST OCCUR IN APPLICANT'S CLAIMED GAME.**
- b) Applicant has an immediate and defined (paytable) payout and Boylan enters a separate bonus event, where there may be no payout. In any event, any bonus payout in this step of Boylan cannot be immediate upon display of the player's and dealer's hand.

It is clear that Boylan does not and cannot anticipate the present claim. **The Examiner is respectfully requested to address any citation within Boylan where the limitations of a) and b) listed above might be found to assist Applicant in better understanding the basis of this rejection.**

- 3) Claims 1-30 have been **NON-finally** rejected under 35 USC 103(a) as unpatentable over US Patent No. 5,863,041 (Boylan) in view of US Patent No. 4,948,134 (Suttle).

#### **Response to Examiner's Comments Made in the Non-Final Rejection**

The Examiner has provided helpful comments on pages 6 and 7 of the Final Office Action that explain the position of the PTO based on responses to arguments previously provided by Applicants. It is believed that these comments can be fairly summarized as follows:

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- a. Boylan is asserted to teach every element of the claimed subject matter except for:
- i. i) providing an additional award to players who have placed an additional wager (e.g., Play wager after placing the Ante wager); and
  - ii. Requiring the Dealer hand to be equal to or less than a predetermined rank to increase the payout to a player making this wager.
- b. Suttle is asserted to teach i) and ii); and
- c. It then is asserted to be obvious to combine the Suttle steps of i) and ii) into the Boylan game to provide a player with more winning chances.

At least one major problem with this analysis is that Suttle does not teach the recited step of "...ii) when a best five-card hand for the dealer is equal to or less than a predetermined rank." Without that teaching, the rejection is fatally flawed.

Suttle actually teaches providing a payout on a Play wager **ONLY when the Dealer hand equals or EXCEEDS a minimum rank**. The play in Suttle awards additional amounts only when the Player's hand is better than at particular ranked hand of the dealer, usually A-K or better. This in effect lets the Dealer fold against the Play wager if the dealer hand has a very low chance of winning against a player hand and the player would be paid on multiple wagers (the Ante and Play wager).

The presently claimed steps require an opposite effect and opposite rule of play. In the claimed subject matter on this Appeal:

**the Dealer can never fold and**

**the player's additional wager (the Play wager) is in play only when the Dealer has a weak hand (equal to or less than a predefined rank).**

This significant play event is not disclosed in Suttle and has significant strategic benefits to players. This difference overcomes some adverse result situations in the play of the Suttle game (Caribbean Stud® poker). One of those significant situations is where the player has a high quality hand, makes the Play wager in expectation of winning multiples on the Play wager, and then wins only on the Ante because the Dealer has a weak (non-qualifying) hand, even though the Player's hand far exceeds the rank of the weak Dealer

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hand. This has been noted by Applicant in the specification as a significant adverse situation in the play of the Suttle game of Caribbean Stud® poker.

The present method offers an optional or mandatory wager (a Play wager against a payable requiring a Dealer to have a relatively low ranking hand) that can allow the player to win, even when the Dealer would have folded in normal play of the Dealer's cards, according to the Rules of Suttle, which require at least an A-K or higher to qualify.

**IT IS ABSOLUTELY CLEAR THAT THE STEP OF HAVING ANY WAGER THAT INCLUDES A PAYOUT SPECIFICALLY AND ONLY WHEN THE DEALER FAILS TO MEET A MINIMUM HAND RANK (e.g., a predetermined hand rank or less, as recited in the claims) IS NOVEL AND UNOBVIOUS.** That recited step is completely absent from the teachings of Boylan and/or Suttle. It provides a different expectation and result from the play of the actual games of Boylan and/or Suttle.

The rejection and the Examiner's comments arguing in support of the rejection are clearly in error. It should be noted that Applicant's are so comfortable and certain of the patentability of their originally claimed subject matter over the rejection of record that no amendments have been filed during the prosecution to avoid this art and the only amendments made are to balance antecedent basis of limitations within the claims.

It is further to be noted that even though the rejection asserts that Boylan teaches every limitation of claim 1 except for the following steps (which is clearly shown to be in error in the discussion of the rejection under 35 USC 102(b) presented above), that fundamental assessment of Boylan in the rejection is in error. The rejection says Boylan is absent a teaching of the limitations of the claims on Appeal only with respect to:

(g) providing an extra award to players who have placed the optional wager:

(i) when the player's best five-card poker hand equals or exceeds a predetermined rank and

(ii) when a best five-card hand for the dealer is equal to or less than a predetermined rank.

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It is then asserted in the rejection that Suttle teaches a method of playing poker (although not Pai Gow poker) which provides an additional award to players who have placed the optional wager (e.g., **placing bet after an "ante"**) when that player's best five-card poker hand equals or exceeds a predetermined minimum rank (Col. 2, lines 32-35; and Col. 4, lines 22-52) **and when** a best five-card poker hand for the dealer is equal to or less than a predetermined rank (e.g., when the dealer's hand is less than Ace-King; Col. 2, lines 32-35; and Col. 4, lines 2-12).

It is asserted to be obvious to provide the poker rule of Suttle to Boylan's Pai Gow poker game to provide more winning chances.

Applicant traverses this rejection at least for the reasons that:

- a. Suttle does not teach the limitations for which it is cited; and
- b. Even if Suttle taught the limitations for which it is cited, the limitations of Suttle could not be merely added to the play of the Boylan game.

It is first to be noted that, after conclusion of the underlying Pai Gow poker game, Boylan actually plays three separate games based on the side bet. There is also a requirement of a greater than minimum side bet, as recited in Boylan as:

**Game 1** - arranging, by the dealer for each player, of a best poker hand consisting of any selected five of the seven cards dealt to each player and formerly comprising the two-card hand and the five-card hand; determining, by the dealer, whether the best poker hand of each player has a poker rank equal to or better than a first predetermined poker rank but less than a second predetermined poker rank; **paying off of the bonus bet by that player if that player has a best poker hand ranked equal to or better than the first predetermined poker rank but less than the second predetermined poker rank;**

**Game 2** - determining, by the dealer, whether the best poker hand of each player has a poker rank better than or equal to the second predetermined poker rank; playing of an auxiliary game of chance by each player having a best poker hand better than or equal to the second predetermined poker rank to determine whether each player is a winner or loser of the auxiliary game; **paying off of the bonus bet to each player having a best poker hand ranked better than or equal to the second predetermined poker rank at**

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**a first payoff where the player is a loser in the auxiliary game** and at a second payoff higher than the first payoff where the player is a winner of the auxiliary game; and

**Game 3** - determining whether each player has made an bonus bet of a predetermined minimum which thus qualifies as an envy bet; and **paying off of any envy bet** by each player if any other player has a best poker hand equal to or better than a third predetermined poker rank.

Game 1 is a limited range bonus bet, with an unusual cap on the amount paid off because of the exclusion of highest ranked hands. This game may be included within a step of the claims on Appeal, but the totality of the claim is still not taught by Boylan in view of Suttle and the claims on Appeal are therefore novel and unobvious over this combination.

Game 2 is a limited bad beat event, paid off only when the player loses the auxiliary game, which might even be an event totally outside the play of the Pai Gow card game (e.g., rolling three dice). This game is not specifically included in the game play claimed by Applicant (although allowed under the claim language of "comprising"). However, this game play method is not equivalent to or within the scope of the last step of Applicant's method of:

- g. providing an additional award to players who have placed the optional wager i) when that player's best five-card poker hand equals or exceeds a predetermined rank and ii) **when a best five-card hand for the dealer is equal to or less than a predetermined rank.**

Additionally, this **highlighted** step (which was specifically recognized as absent from the teachings of Boylan by the Patent and Trademark Office) is not taught by Suttle.

Game 3 is an envy bet wherein if **another player** has a third predetermined high ranked hand, players making a higher than minimum bonus wager win Game 3. This game is within the scope of individual steps in claims of Applicant, noting specifically claim 6, but the totality of the claim is still not taught by Boylan in view of Suttle and the claims on Appeal are therefore novel and unobvious over this combination.



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The step recited in Claim 1:

- g. providing an additional award to players who have placed the optional wager i) when that player's best five-card poker hand equals or exceeds a predetermined rank and ii) when a best five-card hand for the dealer is equal to or less than a predetermined rank.

and the interdependent steps of claim 12:

- f. paying players who have both placed the additional wager and provided hands of at least the predetermined rank according to the pay table and rules of the separate poker-type game played with best five-card hands of the players; and
- g. if a best 5-Card hand for the dealer from the dealer's Pai Gow cards is equal to or less than a predetermined rank, increasing the amount of payment to players from f).

are not taught by Suttle. As these steps, admitted to be absent from Boylan, are not taught by Suttle, and as the very nature of those steps is fundamentally different from either the underlying game of Boylan or the underlying game of Suttle, there is no basis for asserting obviousness of these steps and play that are recited in the claims and not specifically shown in the references.

It is easiest to review the limitation of claim 12 first to appreciate the differences in these unique steps. Claim 12, step f), basically requires paying players for Game 1 of Boylan. **However, this step is substantively modified by step g) in a way not appreciated by the rejection and NOT INCLUDED within the teachings of either of the two cited references.** Step g) states that even if the player wins in step f) (and in fact the player **has to win in step f) by having the predetermined high ranked hand**), the player can win **MORE** than he ordinarily would have if the dealer's best 5-card poker hand equals or is **LESS THAN** a predetermined rank. That is, the player is paid **MORE** when the dealer has a lower range of 5-card poker ranks (e.g., a Pai Gow rank in the 5-Card hand). This is substantively different than the play events in either Boylan or Suttle.

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**As that limitation is not taught, suggested or implied by any reference in the rejection of record, Claims 1 and 12 MUST be novel and unobvious over the combination of references.**

It is first noted that the PTO admits the failure of Boylan to teach that step. However, the steps taught by Suttle will be compared with the steps of the present claims to show the substantive difference between those additional steps of Applicants and the teachings of Suttle in the following Table.

| CLAIM 12 OF APPLICANT   | SUTTLE PROCESS  | COMMENTS  |
|---|---|---|
| b. Players placing an optional wager on a separate poker-type game that uses best five-card hands from player cards;  | Suttle has a mandatory Play wager (after viewing cards) for the player to remain in the game. There is an optional Progressive jackpot wager on a 5-card poker game.      | <b>Both games allow for a side bet, even though the games involved are different.</b>   |
| f. paying players who have both placed the additional wager and provided hands of at least the predetermined rank according to the pay table and rules of the separate poker-type game played with best five-card hands of the players; and | Suttle pays players for predetermined ranks of hands according to a pay table used with the optional side bet.  |   |
| g. if a best 5-Card hand for the dealer from the dealer's Pai Gow cards is equal to or less than a predetermined rank, increasing the amount of payment to players from f).   | Suttle pays the player on the side bet, irrespective of the rank of the dealer's hand. Suttle pays the player on the Ante, irrespective of the rank of the dealer's hand. | Suttle pays the player on the play wager <b>ONLY</b> if the dealer's hand has a minimum rank or <b>HIGHER</b> . Effectively the dealer "folds" with a low hand. |

The impact of the recited rules in claim 12 is that, even where a player has a winning hand in the 5-card poker auxiliary game, the required award resulting from the optional **SIDE BET** is **INCREASED** when the dealer has a particularly low ranked hand.

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Boylan teaches that the player must lose the auxiliary game to be able to win Game 2. That is directly opposite in concept to what is recited in steps f) and g) of Claim 12. In steps f) and g), the player must win step f) to win step g).

Suttle teaches that a win on a mandatory wager (the Play wager, which must be placed by the player if that player wants to remain in the game) occurs only when the dealer hand is **at least a minimum rank (or higher) AND the player beats the actual hand of the dealer**. The effect of a lower than the minimum rank on the dealer's hand is to eliminate or lower one potential award to the player, while the present step g) of claim 12 enables players to **INCREASE AN EXISTING WIN** without further risk when the dealer has a low hand. Again, the effect of a low hand in Suttle is reduced payment to a player and the effect of the same occurrence of a low hand in Claim 12 of Applicant is an increased win. The rules of Suttle and Claim 12 of Applicant tend to be directly opposite in play and impact. **It is impossible for a step of Suttle that is opposite to the step recited in this claim on Appeal can be the basis for an assertion of obviousness.**

Additionally, the rank of the qualifying dealer's hand in Suttle has no impact on the side bet wager. The rank of the dealer's hand does have a positive impact on potential winnings for a player in Claim 12 of Applicant's game.

The rejection attempts to assert the effect of combining the mandatory PLAY wager of Suttle with the effect of the side bet wager of Claim 12 of Applicant, and this attempt is erroneous and confuses the issues rather than establishing obviousness. The PLAY wager of Suttle is not an optional side bet. It is a mandatory wager to stay in the game against the dealer hand. Its function is to maintain the Ante as an active wager in the game. If a player does not make that PLAY wager, the Ante wager is forfeited. That is not a side bet wager, but is a PLAY wager or "base game" wager, similar to a CALL bet in standard poker. The player must call the dealer or the player's hand is folded.

The PLAY wager of Suttle is further distinguished from the language of Claim 12 that requires "**optional wager on a separate poker-type game that uses best five-card hands from player cards.**" The PLAY wager is on the same game as the Ante wager, a game against the dealer hand and not a separate poker-type game.

It is absolutely clear that the more the games steps of play of Suttle are compared to the limitations f) and g) of Claim 12, the greater the difference between the steps, and

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the greater the difficulty (if not impossibility) in asserting obviousness of Claim 12 with respect to Boylan in view of Suttle. The rejection of claims 12-20 has been strongly shown to be in error.

Claim 1 is also non-obvious in view of the combination of Boylan in view of Suttle, for many of the same reasons. Although Claim 1 allows for the **side bet** to be mandatory or optional (while it was only optional in Claim 12), the substance of step g) of Claim 1 is substantially similar to the recitation of both steps f) and g) in Claim 12. Note that the language:

- g. providing an additional award to players who have placed the optional wager i) when that player's best five-card poker hand equals or exceeds a predetermined rank and ii) when a best five-card hand for the dealer is equal to or less than a predetermined rank.

requires **BOTH** the player to win an additional award in a predetermined rank side bet event (step f) in Claim 12) **AND** then for the dealer to have a low ranked hand to provide the player with **an additional award**.

Claims 1-11 are therefore clearly patentable for all the reasons presented above with respect to steps f) and g) (excluding at least the purely optional nature of the side bet).

If the Patent and Trademark Office mistakenly wishes to repeat this fatally defective rejection, explanations of at least the following issues are respectfully requested to be clarified:

- a) No reference shows increasing an existing award when a dealer's hand has a low rank (a predetermined rank or **lower**).
- b) No reference shows an increased award on a side bet when the dealer's hand has a low rank (a predetermined rank or **lower**).

The rejection of claims 1-20 is clearly in error and no amendment to the claims was necessary in providing arguments over the rejections.

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**CONCLUSION**


All rejections of record have been shown in detail to be in error. The rejection should be reversed and all claims should be indicated as allowable.

Applicants believe the claims are in condition for allowance and request reconsideration of the application and allowance of the claims. The Examiner is invited to telephone the below-signed attorney at 952-832-9090 to discuss any questions that may remain with respect to the present application.

Respectfully submitted,  
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Date 25 January 2010

By   
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Mark A. Litman  
Name

Signature 